

REMARKS/ARGUMENTS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 1-23 are pending in the above-identified application, Claims 24-52 are canceled without prejudice or disclaimer, and Claims 1-3, 5-11, 14-15, and 17-23 having been amended. No new matter is added.

In the outstanding Office Action, Claims 19-23 were rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter; Claims 1-2, 10-11, 19-20, and 25 were rejected under 35 U.S.C. § 102(e) as being anticipated by Okubo (U.S. Pat. Pub. No. 2003/0058471); and Claims 3-9, 12-18, and 21-23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Okubo in further view of undocumented assertions as to the nature of executables and software.

In reply, Claim 19-23 have been amended to recite a computer readable storage medium encoded with a computer program configured to cause an information processing apparatus to execute a method, and thus define statutory subject matter. Thus, it is respectfully submitted that the 35 U.S.C. § 101 rejection has been overcome.

The Official Action has rejected Claims 1-2, 10-11, 19-20, and 25 under 35 U.S.C. § 102 as being unpatentable over Okubo. The Official Action contends that Okubo describes all of the Applicants' claimed features. Applicants respectfully traverse the rejection.

Applicants' amended Claim 1 recites, *inter alia*, an image forming apparatus including an application for performing processes on image forming, and a system service for performing processes of a system side of the image forming apparatus on the basis of a request by ***using an API from the application***, the image forming apparatus comprising:

an obtaining unit configured to obtain version information ***of a plurality of APIs used by the application*** for the system service, and version information of ***a plurality of APIs*** corresponding to the system service; and

a comparing unit configured to compare, *API by API*, version information of the one of *the plurality of the APIs* used by the application with version information of the one of the *plurality of the APIs* of the system service.

It is commonly understood that an application program interface (API) is a specific method prescribed by a computer operating system or by an application program by which a programmer writing an application program can make requests of the operating system or another application. APIs are implemented by writing function calls in the program, which provide the linkage to the required subroutine for execution. Thus, an API implies that some program module is available to perform the operation or that it must be linked into the existing program to perform the tasks.

Okubo describes image processing capable of automatically adding or upgrading image processing functions without conducting a test installation of the programs. Although Okubo does discuss programs in general, Okubo does not disclose or suggest the use of APIs. The Official Action cites paragraphs [0082] and [0085] as “an obtaining part for obtaining version information of APIs used by the application for the system service,” and cites paragraph [0086] as “version information of APIs of the system service,” however, it is clear that the claimed feature of “APIs” was not given any weight, as an API is an interface to an application program, not an application program itself. Indeed, the Official Action improperly interprets Okubo’s program as an API. The Office cannot simply ignore the feature of application program interface’s in Applicants’ claims in favor of reading the Applicants’ claims to embrace any type of program.

It is clear that the Official Action has ignored the term “API” in examining the Applicants’ claims. Yet, it is well established that each word of every claim must be given weight. See In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Further, it is well established that while the PTO is to give claim language its broadest “reasonable” interpretation, this does not mean that the PTO can completely ignore the understanding that

the artisan would have of the terminology “API” obtained in light of the specification so as to ascribe a completely different meaning thereto. See In re Cortright, 165 F.3d 1353, 1358, 49 USPQ 2d 1464, 1467 (Fed. Cir. 1999). (“Although the PTO must give claims their broadest reasonable interpretation, this interpretation must be consistent with the one those skilled in the art would reach.”) and In re Okuzawa, 537 F.2d 545, 548, 190 USPQ 464, 466 (CCPA 1976) citing In re Royka, 490 F.2d 981, 984, 180 USPQ 580, 582-83 (CCPA 1974).

Hence, Okubo does not disclose “an obtaining unit configured to obtain version information of a plurality of APIs used by the application for the system service, and version information of a plurality of APIs corresponding to the system service,” as recited in Claim 1.

Accordingly, Applicants respectfully request that the rejection of Claim 1 (and the claims dependent therefrom) under 35 U.S.C. § 102 be withdrawn.

Independent method Claim 10 and independent computer readable medium Claim 19 recite similar features of APIs, as argued above for independent Claim 1. For substantially the same reasons as discussed with regard to Claim 1, it is respectfully submitted that independent Claims 10 and 19 patentably define over the applied art.

With regard to the rejection of Claims 3-9, 12-18, and 21-23 as unpatentable over Okubo in view of undocumented assertions as to the nature of executables and software, it is noted that Claims 3-9, 12-18, and 21-23 are dependent from either Claims 1, 10, and 19, and thus are believed to be patentable for at least the reasons discussed above. Further, it is respectfully submitted that the undocumented assertions as to the nature of executables and software do not cure any of the above-noted deficiencies of Okubo. Accordingly, it is respectfully submitted that Claims 3-9, 12-18, and 21-23 are patentable over Okubo in view of undocumented assertions as to the nature of executables and software.

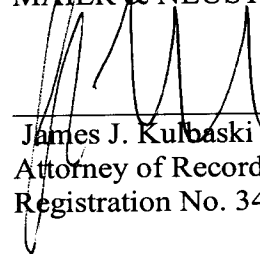
Further, regarding the above-noted undocumented assertions as to the nature of executables and software with regard to Claims 3-9, 12-18, and 21-23, M.P.E.P. § 2144.03

states that it is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record, as the principal evidence upon which the rejection is based. Accordingly, Applicant traverses the 35 U.S.C. § 103(a) rejection based on the undocumented assertions as to the nature of executables and software in the outstanding Office Action for the reason that, without the temporal and structural context by which these features are known to the artisan, it is impossible to conclude that it would be obvious for one of ordinary skill in the art at the time of the invention to combine those noticed features with the art of record. Indeed, the context by which these features are allegedly known might itself provide reasons to rebut a *prima facie* case of obviousness.

Consequently, in view of the present amendment and in light of the above discussions, the outstanding grounds for rejection are believed to have been overcome. The application as amended herewith is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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